

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2225044
BY HEALTH PERCEPTION (UK) LTD
TO REGISTER THE TRADE MARK:**

Allimax

IN CLASS 5

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No 51248
BY ALMIRALL-PRODESFARMA, S.A.
BASED UPON THE EARLIER TRADE MARK:**

ALMAX

TRADE MARKS ACT 1994
IN THE MATTER OF Application No 2225044
by Health Perception (UK) Ltd
to register the trade mark:

Allimax

in class 5

and

IN THE MATTER OF Opposition thereto under No 51248
by Almirall-Prodesfarma, S.A.

Background

1) On 8 March 2000 Health Perception (UK) Ltd applied to register the above trade mark in respect of the following goods:

compositions for medicinal purposes containing substances obtained from plants, vitamins combinations, minerals, amino acids, enzymes and herbal preparations – class 5

The application was published on 3 May 2000.

2) On 1 August 2000 Almirall-Prodesfarma, S.A. filed notice of opposition to this application.

3) The opponent states that he is the registered proprietor of Community trade mark registration no 387175 of the trade mark **ALMAX** which is registered in respect of: “*a special pharmaceutical product used for neutralizing gastric hyperacidity*”. The application was filed on 12 November 1996 and registered on 11 November 1999.

4) The opponent claims that the respective trade marks are similar and encompass identical or similar goods; consequently registration of the application in suit would be contrary to Section 5(2)(b) of the Act. The opponent seeks an award of costs.

5) The applicant filed a counterstatement. He states that ALLIMAX is an extract of the active ingredient in garlic, allicin, and is sold as a food supplement. He states that it is not a pharmaceutical product and that the goods encompassed by the respective trade marks are neither similar nor identical. The applicant states that the goods of the earlier registration are a digestive aid and are classified as a pharmaceutical product. He states that ALMAX is not available in the United Kingdom. The applicant states that as the goods of the earlier registration are not available in the United Kingdom he cannot see how there could be any confusion on the part of the public. With his counterstatement the applicant also a copy of the product packaging which he uses for the goods.

6) Only the opponent filed evidence.

7) The matter came to be heard on 23 April 2002 when the opponent was represented by Helen Thomas-Peter of Wildbore & Gibbons and the applicant was represented by David Wilkie who is the managing director of the applicant.

Opponent's evidence

8) The opponent's evidence consists of a witness statement dated 22 May 2001 by Linda Bray, who is a trade mark attorney.

9) Ms Bray states that the opponent is a leading company in the Spanish pharmaceutical industry. Ms Bray gives further evidence re this matter. I do not see how this relates to the instant proceedings and so will say no more about it.

10) Ms Bray goes on to give a list of European countries where the opponent has registered the trade mark ALMAX.

11) Ms Bray states that the trade mark ALMAX is well-known in Spain and that this was recognised in a decision of the Spanish Patent and Trade Mark Office. She exhibits a copy of this decision at LAB 3, with a translation.

Decision

12) The ground of opposition pursued by the opponent is under sections 5(2)(b) of the Trade Marks Act 1994. The relevant provision reads as follows:

Section 5:

(2) A trade mark shall not be registered if because -

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

The term 'earlier trade mark' is defined in section 6 of the Act as follows:

"6.- (1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks."

13) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224; who is deemed to be reasonably well informed

and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27.

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 224;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* page 224;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 7, paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 8, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 224;

(h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG* page 732, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 9 paragraph 29.

Comparison of goods

14) The goods encompassed by the specification of the earlier registration are: “*à special pharmaceutical product used for neutralizing gastric hyperacidity*”. The goods encompassed by the specification of the application in suit are:

compositions for medicinal purposes containing substances obtained from plants, vitamins combinations, minerals, amino acids, enzymes and herbal preparations

The European Court of Justice held in *Canon* in relation to the assessment of the similarity of goods and/or services that the following factors, inter alia, should be taken into account: their nature, their end users and their method of use and whether they are in competition with each other or are complementary.

15) In her submissions Ms Thomas-Peter referred to the test for similarity of goods given by Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

This test certainly falls within the parameters of *Canon* and so I take it on board in my decision. Ms Thomas-Peters argued that the uses of the respective goods are the same, they are all aimed at making people feel better. The respective users are the same, persons who feel unwell or feel that their physical condition needs improvement in some way. That the physical nature of the goods is the same; absent evidence to the contrary she assumed that all the goods are tablets, capsules or liquid medicines, all to be taken orally. That the respective channels of trade are the same: pharmacies, health food shops or health and beauty sections in a supermarket. She also argued that the respective goods could be in competition as pharmaceutical and health care companies sell a wide range of goods for the treatment of different ailments. For the most part I do not dispute the submissions of Ms Thomas-Peter

16) However, in my consideration of the goods of the application in suit I do not consider that I can lump them all together, as Ms Thomas-Peter did. I first intend to deal with *compositions for medicinal purposes containing substances obtained from plants*. These goods have the same purpose as those of the earlier registration, to act as a palliative or a curative. As such they will have the same end user and use. The respective goods could be sold upon the same shelves in retail outlets. In that the goods of the application in suit under consideration could be for neutralising gastric hyperacidity they would be in competition. Where the goods of the application in suit are not for this purpose I do not consider that they are in competition. One does not normally substitute a preparation for one purpose with one for another purpose; e.g. one would not take a drug for an upset stomach with one for anti-inflammatory. The respective goods could readily be in the same physical form e.g. capsules or tablets. It is also to be noted that there is nothing to preclude the goods of the earlier registration from being derived from plants or containing substances derived from plants. Taking all these factors into account I consider that there is a high degree of similarity with the goods of the earlier registration, even where they are not in competition.

17) I, therefore find that compositions for medicinal purposes containing substances obtained from plants are similar to the goods of the earlier registration.

18) In relation to *herbal preparations* of the application in suit these goods could also be for curing an ailment or as a palliative. In such a context the same arguments as rehearsed in paragraph 16 apply.

19) I now turn to the remaining goods of the application in suit: *vitamins combinations*,

minerals, amino acids, enzymes. Absent evidence to the contrary I must consider these goods in their broadest sense. All the goods could be taken for both curative or palliative purposes e.g. to overcome a vitamin deficiency. Although they could also be taken simply as a supplement to the diet to improve the general health of the user. Their potential palliative or curative uses brings them within the rationale of my considerations in paragraph 16 in relation to all the facets of potential similarity.

20) Consequent upon my considerations in paragraphs 18 and 19 I find that all the remaining goods of the application in suit are similar to those encompassed by the earlier registration. I, however, must admit to a slight reluctance in coming to this conclusion which is born of the general nature of the specification and an absence of evidence in relation to the goods which are encompassed by it.

Comparison of signs

21) The trade marks to be compared are as follows:

Earlier registration:

ALMAX

Trade mark in suit:

Allimax

22) I have no evidence before me that either trade mark enjoys a conceptual association. I am not aware from the position of judicial notice of any conceptual association. I, therefore, treat the respective signs as being invented words. They are, therefore, not conceptually similar. However, this also means that no extra distance is put between the respective signs owing to a conceptual association for one or other of them.

23) Phonetically the only difference between the respective signs is the presence of the letter “i” in the trade mark in suit. I consider that in oral use that this is a very small difference, a difference that could be lost aurally. I, therefore, find that the respective signs are phonetically similar.

24) The earlier registration is in upper case and the trade mark in suit is in title case. I consider that little turns upon this. Visual recognition, recall and awareness will depend on the letters per se rather than upon the case in which they are represented. The respective signs begin with the same two letters and end with the same three letters. Taking into account that the public rarely have the opportunity to compare trade marks side by side and rely upon the vagaries of memory, and consequently can be prey to imperfect recollection, I consider that the respective signs are visually similar.

25) Taking the above into account I find that the respective signs are similar.

Conclusion

26) Ms Thomas-Peter submitted absent evidence to the contrary it is necessary to consider that the signs are used in a normal and fair manner in relation to the goods in question (*Origins*

[1995] FSR 280). The issue of consideration of normal and fair use is also dealt with in *React* [2000] RPC 285. I consider that this is the correct approach to deal with the issues before me.

27) In considering the likelihood of confusion I must make a global assessment. I have to consider the proximity of the signs. I have to take into account that the public seldom compare trade marks directly but rely upon imperfect recollection. I need to bear in mind that according to *Lloyd* mere aural similarity may be enough for a finding of a likelihood of confusion, where the goods are similar; in the instant case there is a high degree of aural similarity between the respective trade marks. I have to consider the proximity of the respective goods, which potentially could be almost identical. I also have to take into account the nature of the purchasing decision. The respective goods are not such that the purchaser would be likely to make a particularly researched purchasing decision. However, the goods are not “bags of sweets” and so he will purchase with some care. I feel, though, taking into account the nature of the goods, that the first concern of the purchaser will be the contents and purpose of the products rather than the trade mark. My final consideration is as to the distinctiveness of the earlier sign. I cannot see that ALMAX refers or alludes to any characteristic for the goods for which it is registered. Absent evidence to the contrary I take it as an invented word and one that enjoys a good deal of inherent distinctiveness. At the hearing Ms Thomas-Peter did not pray in aid to the claim to a reputation in Spain which was included in the evidence of the opponent. She did not consider that this had a bearing upon the case, I agree with her.

28) In his counterstatement the applicant referred to the goods upon which he actually uses his trade mark. The question before me relates to the specification of the application in suit and not the goods upon which he uses his trade mark, except in so far as they might coincide. He states in his counterstatement that the product he sells under the trade mark ALLIMAX is an extract of garlic which is used as a food supplement. The only goods in the specification of the application in suit which these goods would relate to are “*compositions for medicinal purposes containing substances obtained from plants*”. Consequently the goods are defined by the specification as being for medical purposes. I have no evidence before me that the specific goods upon which he states he uses his trade mark could not be used for neutralising gastric hyperacidity. Consequently I cannot presume that they could not be used for this purpose.

29) The applicant also stated in his counterstatement that the opponent does not use his trade mark in the United Kingdom. This might or might not be the case, it is not relevant. The opponent has a Community trade mark registration and so has trade mark rights in the United Kingdom. I have to judge the issues before me on the basis of those rights.

30) At the hearing Mr Wilkie tried to bring in evidence by way of his oral submissions. As I explained at the hearing for evidence to be considered by me they must be by way of statutory declaration, affidavit, witness statement or evidence under oath. It cannot be given by way of oral submission.

31) Taking into account all the above factors I consider that there is a likelihood of confusion in respect of all the specification of the application in suit.

32) However, I have reached the above decision with a certain degree of reluctance. I am not convinced that it reflects the reality of the situation. In his counterstatement the applicant

indicated the specific goods which he was interested in and even supplied a copy of the packaging. In these circumstances I consider it reasonable to consider whether an appropriately limited specification would militate against a likelihood of confusion. I obviously need to consider any such specification within the parameters of the specification as published. Basing such a specification inside these two parameters it would appear to me that the following would be appropriate: “*garlic supplements, all being compositions for medicinal purposes for the heart and blood circulation*”.

33) Based upon the above specification I consider that the purposes of the goods will have a clear difference and so also the users. Yes, the goods will be both for a curative or palliative purpose but for clearly different purposes. In my experience goods such as garlic supplements do not appear on the same shelves or in close proximity to pharmaceuticals. The goods are certainly not in competition, one would not substitute one set of goods for the other. I do not consider that the respective goods are complementary, there is no mutually dependant or symbiotic relationship between them. Both sets of goods are likely to be in tablet form for oral use but I do not consider that this creates a high degree of similarity between them. Taking into account the considerations in *Canon* in relation to the similarity of goods I consider that based upon the above specification that the best that could be said for the opponent is that there would be a very low degree of similarity between the goods. A similarity so low that combined with the fact that the signs are not identical that, on a global appreciation, there would not be a likelihood of confusion.

34) In drafting the above specification, which is a somewhat unusual step, I take into account that Article 13 of the Directive states that only those goods for which there is an objection should be refused and that the applicant was not legally represented. It was also clear to me at the hearing that Mr Wilkie, not surprisingly, did not have a clear understanding of the nature of the questions I have to consider and the basis of the issue of likelihood of confusion.

35) Consequent upon the above decision the applicant should file within one month of the expiry of the appeal period from the decision a form TM21 to restrict the specification to “garlic supplements, all being compositions for medicinal purposes for the heart and blood circulation”. If no form TM21 is filed within the period set the application will be refused in its entirety.

36) The opponent is entitled to a contribution towards his costs and I therefore order the applicant to pay him the sum of £1,100. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29TH day of April 2002

**D.W. Landau
For the Registrar
the Comptroller-General**